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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,947	07/16/2003	Chuck E. Gabbard	190701-1012	8601

24504 7590 06/03/2004

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP
100 GALLERIA PARKWAY, NW
STE 1750
ATLANTA, GA 30339-5948

EXAMINER

ROSEN, NICHOLAS D

ART UNIT PAPER NUMBER

3625

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/620,947

Applicant(s)

GABBARD ET AL.

Examiner

Nicholas D. Rosen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/16/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claims 1-20 have been examined.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it is substantially in excess of 150 words. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: The reference to the parent applications at the beginning of the specification should be updated to give patent numbers as well as application numbers.

Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15, and 18-21 of U.S. Patent No. 6,205,432. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the instant application merely omit certain limitations of the corresponding claims in U.S. Patent 6,205,432, but do not add other limitations that would narrow the scope of a patent granted on the instant application as compared to the '432 patent. Specifically, claim 1 of the instant application merely omits some limitations of claim 1 of the '432 patent. Claims 2-12 of the instant application are then closely parallel to claims 2-12 of the '432 patent. Claim 13 of the instant application adds limitations found in claim 1 of the '432 patent. Claims 14, 15, and 20 of the instant application are then closely parallel to claims 13, 14, and 15, respectively, of the '432 patent. Claim 16 of the instant application, in combination with claim 1 of the instant application, upon which it depends, parallels the limitations of claim 18 of the '432 patent. Claim 17 of the instant application is then equivalent to claim 19 of the '432 patent, claim 18 of the instant application to claim 20 of the '432 patent, and claim 19 of the instant application to claim 21 of the instant application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-12

Claims 1, 3, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williamson ("This E-Mail Message Is Brought to You by . . .", Advertising Age, April 17, 1995) in view of the article, "Novita Communications' New LiveLetter Lets Consumers Add Pizazz to their Email Messages," hereinafter Novita, and official notice. As per claim 1, Williamson discloses an advertising method for inserting a reference to a stored advertisement into an end user communication message in a communications network, said method comprising the steps of: inserting a reference to a stored

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advertisement; and transmitting said end user communication message with said reference to a site on the communications network (second paragraph). Williamson does not expressly disclose receiving an end user communication message at a first site on a communications network, but official notice is taken that it is well known to receive messages at a first site on a communication network (e.g., in sending e-mail, a message is typically received at the sender's ISP's site, and then at the recipient's ISP's site, before being sent to the recipient himself). Hence, it would have been obvious to one of ordinary skill in the art of Internet advertising at the time of applicant's invention to receive a message at a first site, for the obvious advantage of enabling communication between two users who were not directly connected to each other.

Williamson does not disclose that the reference to a stored advertisement is a background reference, but Novita teaches including background images in e-mail (second text paragraph). Hence, it would have been obvious to one of ordinary skill in the art of Internet advertising at the time of applicant's invention to have the reference to a stored advertisement be a background reference, for the obvious advantage of making the reference readily noticeable to the intended reader.

As per claim 3, Williamson discloses that the message is an e-mail message (second paragraph). Williamson does not expressly disclose that the e-mail message is an Internet e-mail message, but official notice is taken that it is well known for e-mail messages to be Internet e-mail messages; moreover, Williamson's description of linking the e-mail user to more information suggests using the Internet, rather than sending e-mail over a local and private computer system. Hence, it would have been obvious to

one of ordinary skill in the art of Internet advertising at the time of applicant's invention to have the e-mail message be an Internet e-mail, for the obvious advantage of communicating to the vast number of e-mail users who are on the Internet.

As per claim 12, Williamson does not expressly disclose that the stored advertisement is a graphical image file, but official notice is taken that the use of graphical images on the Internet and particularly in advertising is well known. Hence, it would have been obvious to one of ordinary skill in the art of Internet advertising at the time of applicant's invention to have the stored advertisement be a graphical image file, for the obvious advantage of catching potential customers' eyes with graphical images.

Claims 2, 5, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williamson, Novita, and official notice as applied to claim 1 above, and further in view of Cordell et al. (U.S. Patent 5,778,372). As per claim 2, Williamson does not disclose that the background reference is operative for enabling background tiling of the advertisement at the second site, but Novita's teaching of "background textures and images" is suggestive of tiling, and Cordell teaches background tiling (column 6, lines 44-67). Hence, it would have been obvious to one of ordinary skill in the art of Internet advertising at the time of applicant's invention to make the background reference operative for enabling background tiling of the advertisement at the second site, for the obvious advantage of making the references readily noticeable to the intended reader.

As per claim 5, Williamson does not disclose transforming the end user communication message into HTML, but Cordell teaches sending messages in HTML (e.g., column 6, lines 17-67). Furthermore, official notice is taken that it is well known to

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transform communication messages, including e-mail messages, into HTML. Hence, it would have been obvious to one of ordinary skill in the art Internet advertising at the time of applicant's invention to transform the end user communication message into HTML, for the obvious advantage of enabling the message to be presented with an eye-catching background design, links, and other features available through HTML.

Williamson does not expressly disclose transmitting end user communication messages in a web-based e-mail system to a web browser at the second site, but official notice is taken that web browsers and web-based e-mail are well known. Hence, it would have been obvious to one of ordinary skill in the art of Internet advertising at the time of applicant's invention to transmit the end user communication message in a web-based e-mail system to a web browser at a second site, for the obvious advantage of making the end user communication message and associated advertising available to people using web-based e-mail systems.

As per claim 9, Williamson does not expressly disclose inserting an HTML background reference tag into the end user communication message, but Cordell teaches inserting an HTML background reference tag (column 6, lines 44-67). Hence, it would have been obvious to one of ordinary skill in the art of Internet advertising at the time of applicant's invention to insert an HTML background reference tag into the end user communication message, for the obvious advantage of providing for Web links, background tiling, and other features that can be accomplished through HTML.

Claims 4, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williamson, Novita, and official notice as applied to claim 1 above, and further in

view of Lois-Bujold Digest 1085. As per claim 4, Williamson does not disclose that the end user communication includes a public posting, but Lois-Bujold Digest 1085 provides an example of a public posting of a message including a reference to an advertisement. An e-mail message from Ellen Blackburn (page 3) concludes with an inserted advertisement for Yahoo!, Mrs. Blackburn's ISP. The digest which includes this advertisement became publicly available on the World Wide Web. Hence, it would have been obvious to one of ordinary skill in the art of Internet advertising at the time of applicant's invention to have the end user communication message include a public posting, for the obvious advantage of putting the advertisement before the public.

As per claim 10, Williamson does not expressly disclose storing the stored advertisement at the first site, but in the Lois-Bujold Digest, the stored advertisement for Yahoo! which follows Ellen Blackburn's post (page 3) is stored at the Yahoo! site, and Mrs. Blackburn's post was from her e-mail account at Yahoo! Hence, it would have been obvious to one of ordinary skill in the art of Internet advertising at the time of applicant's invention to store the stored advertisement at the site where the end user communication message is first received, for the obvious advantage of needing to use only one site, with consequent savings in the costs of registration and maintaining servers.

As per claim 11, again referring to Lois-Bujold Digest 1085, the file address given in the advertisement for Yahoo! (page 3) is remote from the second sites where most of the list members received their e-mail (see names and e-mail addresses on page 1), and also remote from the herald.co.uk site where the Digest was stored. Hence, it

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would have been obvious to one of ordinary skill in the art of Internet advertising at the time of applicant's invention to have the stored advertisement stored at a site remote from the second site, and to have the reference include a file address remote from the second site, for the obvious advantage of not needing to store advertisements at all the sites used by a plurality of message recipients.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williamson, Novita, and official notice as applied to claim 1 above, and further in view of the admitted prior art. Williamson does not disclose transmitting the end user communication in a POP format, but it is admitted prior art that POP is a standard format for handling e-mail (the instant application, page 3, lines 5-9). Hence, it would have been obvious to one of ordinary skill in the art of Internet advertising at the time of applicant's invention to transmit the end user communication in a POP format, for the obvious advantage of making the advertisement known to those using a common format for reading e-mail.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williamson, Novita, and official notice as applied to claim 1 above, and further in view of Carles (U.S. Patent 5,515,098). Williamson refers to demographic information (sixth paragraph); if that is not sufficient, Carles further teaches selecting the stored advertisement based on user demographic information (Abstract). Hence, it would have been obvious to one of ordinary skill in the art of Internet advertising at the time of applicant's invention to select the stored advertisement based on user demographic

information, for the obvious advantage of presenting users with advertisements likely to induce them to buy, and thus being able to charge more to advertisers.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williamson, Novita, and official notice as applied to claim 1 above, and further in view of Mosley-Matchett ("Eyeball' the Validity of Internet Ad Measures"). Williamson does not disclose selecting a stored advertisement based on advertisement exposure for a pool of advertisers, but Mosley-Matchett teaches selecting an ad based on advertisement exposure (eleventh text paragraph, beginning "Impressions differ . . ."). Hence, it would have been obvious to one of ordinary skill in the art of Internet advertising at the time of applicant's invention to select a stored advertisement based on advertisement exposure, for the obvious advantage of showing people advertisements to which they had already been exposed, or already been repeatedly exposed, thus providing a more valued audience to advertisers.

Mosley-Matchett does not expressly teach that this is done for a pool of advertisers, but official notice is taken that it is well known for advertising to be done by a pool of advertisers. Hence, it would have been obvious to one of ordinary skill in the art of Internet advertising at the time of applicant's invention to select an advertisement based on exposure for a pool of advertisers, for the obvious advantages of selling advertising a number of advertisers, and having a larger pool of advertisements to rotate in showing people.

Allowable Subject Matter

Claims 13-15 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and further upon filing of a valid terminal disclaimer.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, Williamson, discloses an advertising method for inserting a reference to a stored advertisement in an end user communication message, according to claim 1, Novita teaches the use of background images in e-mail, and other limitations of claim 1 are held to be obvious in view of well-known facts of which official notice has been taken. However, neither Williamson, Novita, nor any other prior art of record discloses determining whether said end user communication message is in a format capable of operatively accepting said background reference; and converting said end user communication message into a format capable of operatively accepting said background reference responsive to determining that said message is not in a format capable of operatively accepting said background reference. There is prior art, such as Francis et al. (U.S. Patent 6,182,092), for converting formats not capable of operatively accepting a background reference to a format so capable (e.g., converting Microsoft Word to HTML), but no prior art of record which teaches performing the conversion of an end user communication message into a format capable of operatively accepting a background reference responsive to determining that said message is not in a format capable of operatively accepting said background reference, and particularly no prior art

of record which teaches doing so in the context of an advertising method for inserting background references.

Claims 16-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and further upon filing of a valid terminal disclaimer.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, Williamson, discloses an advertising method for inserting a reference to a stored advertisement in an end user communication message, according to claim 1, Novita teaches the use of background images in e-mail, and other limitations of claim 1 are held to be obvious in view of well-known facts of which official notice has been taken. However, neither Williamson, Novita, nor any other prior art of record discloses: first determining whether said end user communication message is in a format capable of operatively accepting a background message; second determining whether said end user communication message contains a standard generalized markup language (SGML) part responsive to determining that said end user communication message is in a format capable of operatively accepting a background reference in said first determining step; and adding an SGML part to said end user communication message responsive to determining that said end user communication message does not contain an SGML part. Adding SGML is not held to be novel, but there is no prior art of record teaching the combination of steps, particularly not in the

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context of adding a background advertising reference to an end user communication message.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Francis et al. (U.S. Patent 6,182,092) disclose a method and system for converting between structured language elements and objects embeddable in a document. Friend (U.S. Patent 6,728,757) discloses smart HTML electronic mail.

The art of record in parent case U.S. Patent 6,633,850 (application 09/567,250) is made of record in the current case. Applicant is presumed to have access to it; however, copies of the art actually used in making rejections are provided.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. (Wynn Coggins is currently on assignment elsewhere in the Patent Office; the examiner's acting supervisor, Jeffrey Smith, can be reached at 703-308-3588.) The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Non-official/draft communications can be faxed to the examiner at 703-746-5574.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas D. Rosen
NICHOLAS D. ROSEN
PRIMARY EXAMINER

May 24, 2004